

REMARKS/ARGUMENTS

In the Office Action mailed April 30, 2003, the specification (p. 12, lines 16-19) and claims 17 and 18 were objected to due to informalities caused by typographical errors. Accordingly, the specification and claims 17 and 18 have herein been amended to correct the typographical errors. Support for these amendments is found in the specification (p. 19, lines 5-6 and p. 22, lines 12-13). It is believed that no new matter has been added to the application via these amendments.

Claim 7 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Accordingly, claim 7 has herein been amended to correct a typographical error. Support for this amendment is found in the specification (p. 9, line 3 - p. 10, line 15). It is believed that no new matter has been added to the application via this amendment.

In the Office Action, the drawing was objected to as being included in the specification instead of in a separate section. Accordingly, an amendment has herein been made to remove the drawing from the specification and to include it in a separate section. The drawing has herein been amended to remove the original page number and page header (which included the applicant's case docket number and the application's Express Mail No.) from the drawing. It is believed that no new matter has been added to the application via this amendment.

Claims 1-14 and 19-20 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 4,689,102 to Prawdzik et al. in view of U.S. Patent No. 6,429,247 to Shah et al. and U.S. Patent No. 5,498,659 to Esser. The rejection is respectfully traversed.

Independent claim 1 in the present application has been written in the "Jepson" format. As stated by the court in *Naso v. Part*, 856 F. Supp. 201, 34 U.S.P.Q. 2d 1463, 1465 (N.Y. 1994):

Such claims are favored because they clearly separate the elements of the overall combination which are admittedly old from those which are claimed as new.

As noted in the application, traditional processes of producing high pressure laminates using conventional release sheets are known (see p. 1, line 17 – p. 2, line 16; p. 4, line 1 – p. 5, line 3). The improvement in the method of the present application over such traditional high pressure laminate production processes is the use of a release sheet having at least outer surface coated with

the aqueous polymeric release coating composition taught in the application, which provides excellent separation properties.

U.S. Patent No. 4,689,102 to Prawdzik et al. is cited in the Office Action as disclosing a traditional method of forming a conventional high pressure laminate with several layers of core stock impregnated with thermosetting resin, decorative sheet, and release sheet (having at least one surface which includes a B-stage cured coating of a compositions comprised of abrasion-resistant mineral particles dispersed in a resinous matrix) inserted between the sheet assemblies to ensure separation of the assemblies from each other. However, as stated in the Office Action Prawdzik et al. does not disclose the release coating compositions taught by the applicant.

In the Office Action, commonly assigned **U.S. Patent No. 6,429,247 to Shah et al.** is cited as disclosing “a coating composition for functional paper coating, (Col. 1, lines 27-33) which is considered to include release coating.” However, neither the production of high pressure laminates nor the formulation of release coatings are mentioned anywhere in Shah et al. – indeed, the word “release” does not even appear in the patent.

It is important to note that Shah et al. teaches and claims the production of **rosin**-fatty acid vinylic emulsion compositions. Thus, the Shah et al. compositions are significantly different from the aqueous polymeric release coating compositions taught by the applicant, as the applicant’s compositions do not contain rosin.

In his accompanying 37 C.F.R. § 1.132 Declaration, Dr. Thomas M. Sisson (who is a co-inventor of U.S. Patent No. 6,429,247) states that one skilled in the art would understand that **rosin** is a tackifier and an **adhesion promoter**. Indeed, one of the fundamental properties exhibited by Shah et al.’s rosin-fatty acid vinylic emulsion compositions is an enhanced adhesion to substrates (col. 2, lines 35-39; col. 4, lines 49-62; col. 5, lines 27-30 and lines 38-53; col. 6, lines 12-16; and col. 18, lines 50-63).

As noted in the application, a principal purpose of employing release sheets coated with the aqueous polymeric compositions taught in the applicant’s method is to permit high pressure laminates to be easily separated (p. 5, lines 20-22). It is, therefore, respectfully submitted that a skilled artisan would recognize that adhesion between substrates is precisely what the applicant’s release coatings are utilized to prevent. Accordingly, it is further respectfully submitted that, due to the adhesive nature of the rosin-fatty acid vinylic emulsion compositions taught by Shah et al.,

one skilled in the art would not expect such compositions to function as a release coating – much less as a release coating which is suitable for use in the production of high pressure laminates.

In page 4 of the Office Action, **U.S. Patent No. 5,498,659 to Esser** is cited as disclosing “a composition for coating such as floor polishes, paints, adhesive, and finishes and treatments for paper such as release coating depending on the amount of ingredients used”. Like Shah et al., Esser does not even contain the word “laminate” or any teachings or suggestions concerning the production of high pressure laminates. While the phrase “release coatings” does occur once in the patent, what Esser specifically states (col. 5, lines 50-59) is that:

Further in that regard, various specific aqueous polymeric formulations produced in accordance with the principles of the present invention are able to provide certain “finishes” as well as other surface “treatments” for a number of relatively thin substrates such as paper, wherein such “finishes” and surface “treatments” are able to crosslink without liberating formaldehyde. Such an end-use is particularly desirable, for example, in the production of “release” coatings, overprint varnishes, and especially in relation to the production of rotogravure coatings (emphasis added).

Thus, the only suggestion contained in Esser which relates to any potential use of his aqueous polymeric formulation as a release agent expressly teaches the desirability that such release agent to be able to crosslink (without liberating formaldehyde). Indeed, Esser specifically teaches and claims polymeric compositions that are able to provide substrates with **crosslinked** polymeric surface coatings (col. 1, lines 9-12; col. 5, lines 3-10; col. 7, lines 63-67; col. 13, lines 26-55; col. 14, lines 41-45; col. 15, lines 13-21; col. 16, lines 43-55; and claim 1). It is respectfully submitted that a skilled artisan would recognize that Esser’s compositions fundamentally differ from the aqueous polymeric release coating compositions taught by the applicant, in that the applicant’s compositions do not undergo crosslinking.

Moreover, Esser’s compositions must contain **amine**-functional moieties (claim 1). Again, this fundamentally differs from the aqueous polymeric release coating compositions taught by the applicant, which do not contain amine-functional moieties.

Also, the stabilizing chemistry employed by Esser is a water/surfactant combination. Esser’s compositions do not contain **water-dispersible stabilizing polymers**. Again, this fundamentally differs from the applicant’s aqueous polymeric release coatings, which contain water-dispersible stabilizing polymers. Thus, as Dr. Sisson states in the accompanying

Declaration, one skilled in the art would recognize that Esser teaches a non-supported polymer, while the applicant teaches a supported polymer.

As noted by Dr. Sisson, a skilled artisan would understand that the non-stabilized, amine-containing, crosslinked polymeric formulations taught by Esser would exhibit very different chemical, physical, and performance properties than those exhibited by the stabilized, non-amine containing, non-crosslinked polymeric coating compositions taught by the applicant.

As the court stated in *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988):

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that a claimed process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure.

To summarize, each of the respective compositions taught in Prawdzik et al., Shah et al., and Esser differ significantly from the aqueous polymeric release coating compositions employed in the applicant's method. It is, therefore, respectfully submitted that neither Prawdzik et al., Shah et al., nor Esser, either alone or in combination, would teach or suggest the applicant's improved method of laminating sheets to a skilled artisan – much less that the method would be successful.

It is further respectfully submitted that, in the absence of the applicant's teachings, there would be no suggestion or motivation to one skilled in the art to even attempt to combine the Prawdzik et al., Shah et al., and Esser references – and that such an attempted combination would invariably be the result of improper hindsight analysis. As the court stated in *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references or record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Claims 15 and 16 stand rejected under 35 U.S.C. 103(a) as being obvious over Prawdzik et al. (U.S. Patent No. 4,689,102) in view of Shah et al. (U.S. Patent No. 6,429,247) and Esser (U.S. Patent No. 5,498,659), and further in view of **Bishop** (UK 1,260,477). The rejection is respectfully traversed.

Bishop is cited in the Office Action as disclosing a release coating that is suitable for use with wallpaper which contains wax in the amount of 10% to 30% by weight of the total composition. However, it is respectfully submitted that Bishop does not teach, suggest, or even hint at the applicant's method of laminating sheets or the aqueous polymeric release coating compositions employed by the applicant in that method. Accordingly, for the reasons stated above - and as noted by Dr. Sisson in the accompanying declaration - it is respectfully submitted that neither Bishop, Prawdzik et al., Shah et al., nor Esser, either alone or in combination, would teach or suggest the applicant's improved method of laminating sheets to a skilled artisan. It is further respectfully submitted that, in the absence of the applicant's teachings, there would be no suggestion or motivation to one skilled in the art to even attempt to combine the cited references - and that such an attempted combination would invariably be the result of hindsight analysis.

Claims 17 and 18 stand rejected under 35 U.S.C. 103(a) as being obvious over Prawdzik et al. (U.S. Patent No. 4,689,102) in view of Shah et al. (U.S. Patent No. 6,429,247) and Esser (U.S. Patent No. 5,498,659), and further in view of U.S. Patent No. 4,513,059 to **Dabroski**. The rejection is respectfully traversed.

Dabroski's method for the production of pressure sensitive adhesive paper tape is cited in the Office Action as disclosing the application of a release coating to provide a dry coating weight of about 0.2 to about 0.4 ounce per square yard (claim 4). However, it is respectfully submitted that Dabroski does not teach, suggest, or even hint at the applicant's method of laminating sheets or the aqueous polymeric release coating compositions employed by the applicant in that method. Accordingly, for the reasons stated above, - and as noted by Dr. Sisson in the accompanying declaration - it is respectfully submitted that neither Dabroski, Prawdzik et al., Shah et al., nor Esser, either alone or in combination, would teach or suggest the applicant's improved method of laminating sheets to one skilled in the art. It is further respectfully submitted that, in the absence of the applicant's teachings, there would be no suggestion or motivation to one skilled in the art to even attempt to combine the cited references - and that such an attempted combination would invariably be the result of hindsight analysis.

Therefore, for the reasons stated, it is respectfully submitted that the claimed invention as amended is patentable and that the claims are in condition for allowance. Such action by the Examiner is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

No additional fees (other than for the time extension included herein) are believed to be due in connection with the filing of this amendment and response. Should it be determined that additional fees are due and payable, the Commissioner is authorized to charge any required fees or credit any overpayment to the assignee's Deposit Account No. 23-1160.

Respectfully submitted,

MEADWESTVACO CORPORATION

By



Daniel B. Reece IV
Attorney for the Applicant
Registration No. 33,998

Attachment

Date: October 29, 2003
5255 Virginia Avenue
Post Office Box 118005
Charleston, SC 29423-8005
Telephone (843) 746-8493